

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB    MAY 23, 00  
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Advance Paradigm, Inc.

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Serial No. 75/268,823

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Elisa P. Rosen of Dow, Lohnes & Albertson, PLLC for Advance  
Paradigm, Inc.

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(Thomas Lamone, Managing Attorney)

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Before Hanak, Chapman and McLeod, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Advance Paradigm, Inc. filed on April 3, 1997 an  
intent-to-use application seeking to register the mark  
ADVANCE PARADIGM and design (shown below) for "providing  
cost management programs and services for health benefit  
plans for others."

Citing Section 2(d) of the Trademark Act, the examining attorney refused registration on the basis that purportedly applicant's mark, if applied to applicant's services, would be likely to cause confusion with the mark PARADIGM, previously registered in typed drawing form for "computer software in the fields of employee benefit consulting and health insurance services." Registration No. 1,985,915.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the examining attorney filed briefs. Applicant did not request a hearing.

We find that there exists no likelihood of confusion, and accordingly reverse the refusal to register. We do so for two primary reasons.

First, applicant has established that as described in its application, its services are marketed only to sophisticated buyers who engage in lengthy negotiations with applicant before entering into a multi-million dollar contract with applicant. In other words, by definition

"providing cost management programs and services for health benefit plans for others" are simply not services that are casually purchased by ordinary consumers. Rather, they are purchased by senior management of employers who exercise great care in selecting which company will provide these multi-million dollar services to the employers for the ultimate benefit of their employees.

The examining attorney never disputes that the purchasers of applicant's services are, by definition, sophisticated. Indeed, she concedes this very point. (Examining attorney's brief page 4). Thus, while it is conceivable that senior management of an employer considering the purchase of applicant's services may have been exposed to registrant's PARADIGM computer software, we find that applicant's mark containing the word ADVANCED and a sunburst design is dissimilar enough from registrant's mark PARADIGM per se such that these sophisticated purchasers would not confuse applicant's very expensive services with registrant's computer software. As our primary viewing Court has made abundantly clear, purchaser "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir.

1992) (The Court found no likelihood of confusion resulting from the contemporaneous use of applicant's mark E.D.S. and opposer's mark EDS despite the fact that "the two parties conduct business not only in the same fields but also with some of the same companies." 21 USPQ2d at 1391).

Second, applicant has established that there are numerous third-party registrations of marks consisting of or containing the word PARADIGM for services which are related to applicant's services or for goods which are related to registrant's goods. Each of these third-party registrations is owned by a different entity. Among the third-party registrations are (1) PARADIGM for providing doctors and nurses for staffing health care facilities; (2) PARADIGM for physical rehabilitation services; (3) PARADIGM and design for financial planning related to employee benefits including disability benefits; and (4) at least five PARADIGM registrations for various types of computer software including computer software for human resource management. Thus, it appears that the term PARADIGM is hardly a unique term for use in connection with either various types of health services or various types of computer programs. The existence of this fairly large number of PARADIGM registrations for services and goods

which are related to registrant's goods and applicant's services is yet another reason for finding that there exists no likelihood of confusion.<sup>1</sup>

Decision: The refusal to register is reversed.

E. W. Hanak

B. A. Chapman

L. K. McLeod  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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<sup>1</sup> We would be remiss if we did not note that applicant failed to submit actual copies of these third-party registrations. Instead, applicant merely submitted a list of these registrations which included the (1) registration numbers; (2) the marks; and (3) the goods and/or services. This Board has repeatedly stated that normally "the submission of a list of registrations is insufficient to make them of record." In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). However, an exception exists where during the course of the examination process, applicant submits such a list and the examining attorney in no way objects to this mere list or indicates that the proper method is to submit actual copies of the registrations. Indeed, in this case the examining attorney not only failed to do the foregoing, but in addition, she discussed the merits of this list of third-party registrations and, in effect, treated the list as making the third-party registrations of record. Accordingly, we have done likewise.